

### **REMARKS**

Applicants appreciate the Examiner's attention to the above referenced application. Claims 1-18 were rejected. Claims 1, 2, 6-8, 12, 14, and 16 have been amended. Claims 1-18 are now pending, of which claims 1, 7, and 12 are independent.

### **Objection to the Drawings**

The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) because they allegedly include the following reference character(s) not mentioned in the description: 518 (Figure 5), 910 and 914 (Figure 9). Applicants respectfully request clarification of this objection, as Applicants can find no reference character 518 in Figure 5. Reference character 318 appears in Figure 5, and reference character 318 is described in the originally-filed specification on page 8 lines 14-15, inter alia.

With regard to reference characters 910 and 914, Applicants have amended the specification to include the inadvertently-omitted reference characters along with the original text description. Applicants respectfully request withdrawal of the objection to the drawings and respectfully request that the application be allowed to pass to issuance.

### **35 USC § 101 Rejection of the Claims**

Claims 7-11 were rejected under 35 USC § 101 because the claimed invention was indicated to be directed to non-statutory subject matter. The specification has been amended to eliminate the reference to a carrier wave in response to this rejection. Applicants respectfully submit that claims 7-11 are now in condition for allowance and respectfully request that claims 7-11 be allowed to pass to issuance.

### **35 USC § 102 (b) Rejection of the Claims**

Claims 1, 3, 5-7, 9, 11-18, were rejected under 35 USC § 102(b) as being unpatentable over Ohara et al. (US Patent No. 5,739,814, hereinafter "Ohara."). Independent claims 1, 7, and

12 have been amended to include substantially similar limitations that distinguish the invention from the Ohara reference. Amended claim 1 is shown below.

1. A method of associating a selected object on any pre-existing printed material to a valid response provided by a computer system comprising:

determining a position of an electronic pen on a page of the pre-existing printed material, wherein the pre-existing printed material has not been modified for use with the computer system and the electronic pen;

transmitting the position to the computer system;

correlating the position to selected content associated with the printed material, the selected content being accessible by the computer system; and

providing a valid response to a user based at least in part on the position and the correlated content, wherein the valid response includes at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system.

Ohara is not designed to work with pre-existing printed materials, and in fact, Ohara requires an electronic book that has been specifically adapted to operate with the computer system. Ohara repeatedly describes the book as an “electronic book” containing “sheet cards” containing image data and the like that are “printed or recorded one at a time.” (See column 1, lines 8-12; column 2, lines 29-37.) The electronic book is also described as having a spline specially adapted to include electronic terminals and pages printed with conductive paint or ink. See Ohara, column 6, lines 61-67 and Fig. 7.

In marked contrast, the present invention works with pre-existing printed material that “has not been modified for use with the computer system and the electronic pen.” The present invention does not rely on special preparation of the physical material at all. The present invention uses image analysis techniques to determine, based on the identification of the physical material (e.g., which book, and which page within a book) and the current pointing position (as determined by the electronic pen), what action to take. With the present invention, any pre-existing book, magazine, or other printed material can be used to provide an interactive

experience to the user. No special preparation is required for the physical object prior to use. Embodiments of the present invention may be used to cause resulting actions when a book is put in the holding structure and pointed to by the user with the electronic pen. The computer system/computer program needs to know which book is being used by the user (since the scanned digital images of each book's pages and actions corresponding to selections of locations of each page must be prepared in advance of use). However, no preparation of the book itself is done. In this way, an educational or entertaining interactive experience can be provided for any book, magazine or other object that exists, not just books specifically fitted with electronic terminals and prepared with special ink by a manufacturer as in Ohara.

Because Ohara does not teach a system, article, or method designed to operate with pre-existing printed material that "has not been modified for use with the computer system and the electronic pen," Applicants respectfully submit that the amended independent claims are now in condition for allowance. Applicants respectfully request that claims 1-18 be allowed to pass to issuance.

### **35 USC §103 (a) Rejection of the Claims**

Claims 2 and 8 were rejected under 35 USC § 103(a) as being unpatentable over Ohara et al (US Patent No. 5,739,814) in view of Wood et al. (US Patent No. 6,414,673 B1, hereinafter "Wood"). Independent claims 1 and 7, from which claims 2 and 8 depend, have been amended to overcome the rejection in light of the Ohara reference, as argued above. Wood does not overcome the failure of the Ohara reference to teach working with pre-existing printed material that that "has not been modified for use with the computer system and the electronic pen." Applicants respectfully submit that the amended claims are now in condition for allowance. Applicants respectfully request that claims 2 and 8 be allowed to pass to issuance.

Claims 4, 10, and 14 were rejected under 35 USC § 103(a) as being unpatentable over Ohara et al (US Patent No. 5,739,814) in view of Amano et al. (US Publication No. 20040119696 A1, hereinafter "Amano"). Independent claims 1, 7, and 12, from which claims 4, 10, and 14 depend, have been amended to distinguish the Ohara reference. Amano does not

overcome the failure of the Ohara reference to teach working with pre-existing printed material that that “has not been modified for use with the computer system and the electronic pen.” Applicants respectfully submit that the amended claims are now in condition for allowance. Applicants respectfully request that claims 4, 10, and 14 be allowed to pass to issuance.

**CONCLUSION**

Applicant respectfully requests Applicants respectfully request reconsideration in view of the remarks and amendments set forth above. If the Examiner has any questions, the Examiner is encouraged to contact the undersigned at (512) 732-1303. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0221 and please credit any excess fees to such account.

Respectfully submitted,

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